

U.S. Patent Application No. 09/937,016  
P21432.A12 (894/US/PCT)

## **REMARKS**

### **Status of the Claims**

Upon entry of the amendment above, claims 14-44 and 47-64 will remain pending, claims 14, 15, 29, 30, 44, and 58 being independent.

### **Summary of the Office Action**

Claim 24 is indicated as containing allowable subject matter but is objected to for depending upon a rejected claim.

Claims 29, 32,-34, 42, and 53 are rejected under 35 USC §102(b) as being anticipated by PHILLIPS et al. (U.S. Patent No. 3,783,534, hereafter "PHILLIPS").

Claims 14-23, 25-28, 30, 31, 35-41, 43, 44, 46-52, and 54-61 are rejected under 35 USC §103(a) as being unpatentable over PHILLIPS in view of ELLIS et al. (U.S. Patent No. 3,206,874, hereinafter "ELLIS").

### **Response to the Office Action**

#### **A. Summary of Amendment**

Applicant has amended certain paragraphs of the specification to improve its form (such as "fixing point" to "attachment point", and other such revisions). Paragraph 0033 has been amended for the purpose of improving its form and to describe features of the cover 1 that are shown in the drawings as originally filed, such as the cover having a generally concave contour in transverse cross section along its length and that, as shown in Fig. 4, that the cover has sufficient rigidity to retain its shape in the open position thereof. In paragraph 0036, as also is shown in Figs. 2-5, the articulation of the cover with respect to the sole of the boot is made between the top and bottom of the sole.

Independent claims 14, 15, 29, and 44 have been amended to refer to the aforementioned articulation of the cover between the top and bottom of the sole.

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Independent claim 30 has been amended to further specify that the cover comprises a *continuous* rigid or semi-rigid material that extends continuously within the upper part of the cover, through the intermediate part, and within the lower part, and that the cover is connected to the sole so that said continuous material enables the transmission of forces from the wearer's leg to the sole of the boot.

Dependent claim 46 has been canceled, its subject matter appearing in claim 44.

Dependent claims 47, 50, 52, and 55-57 have also been amended.

Independent claim 58 has been amended by adding a limitation at its end referring to the attachment of the front spoiler to the sole at two spaced apart attachment points (see, e.g., points at openings 3 in Applicant's Fig. 1) and that the rigid material of the front spoiler enables transmission of forces from the tibial support zone of the upper to the sole.

No prohibited new matter has been introduced.

#### **B. Summary of the Invention**

The invention is directed to an article of footwear and, in a particular embodiment, a shoe that includes a high upper, *i.e.*, an upper that extends above the ankle of the wearer and which is positioned along the lower leg of the wearer, such as in front of the tibia of the wearer.

A particular field of endeavor to which the invention is directed is that of snowboarding. As explained in the background and summary sections of the specification of the instant application, current snowboard boots (and other sports boots) must satisfy various demands of the user, some of which are contradictory. For example, a boot should be comfortable for the user and, for example, should enable him/her to perceive plantar sensations during the sport, *i.e.*, during snowboarding. On the other hand, if the upper of the boot is not sufficiently rigid, the transmission of forces from the rider to his/her board is less than optimum.

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According to the invention, then, at least the front-to-rear rigidity of the boot is enhanced by means of a cover, *i.e.*, a front spoiler, whereby the tibial support zone of the boot is less easily flexed about the flexion fold (*i.e.*, the flexion crease) of the boot toward the front end zone of the boot. Thus, with the cover in place on the boot, in which the cover extends from at least the front end zone of the boot and into the flexion fold zone, the cover interferes with the free flexing of the boot that would be possible without the cover.

Further, as explained in paragraph 0012 of the specification, with the rigidity of the cover, or front spoiler, in the context of snowboarding, the rider is able to transmit forces (such as for steering the board) from his/her lower leg to the board, via the rigid cover/spoiler to the sole of the boot.

**C. Withdrawal of Rejection Under 35 USC §102(b)**

Applicant requests that the two grounds of rejection, both based upon PHILLIPS, solely or in combination with ELLIS, be reconsidered and withdrawn. The rejection of claims 29, 32-34, 42, and 53 for anticipation over PHILLIPS will first be addressed.

PHILLIPS discloses an off-road motorcycle boot intended to protect the cyclist's shin and lower leg against injury by being struck by items such as brush during trail riding. See, e.g., column 3, lines 34-39 of PHILLIPS.

To provide such protection (see column 2, lines 25-52), PHILLIPS equips his boot with rigid strips 42 and 43 which are embedded between two layers of the sides 20 of the upper 14 of the boot, extending between the ankle and knee. In addition, PHILLIPS equips the tongue 30 of his boot with a rigid strip 40 between two layers of material which make up the tongue for protecting the shin (column 2, lines 39-40).

PHILLIPS does *not* teach or suggest that the tongue 30, identified in the Office action as a "protective cover," is rigid or semi-rigid. In fact, PHILLIPS is silent as to the material from which the tongue 30 is made. In column 2, lines 35-37, PHILLIPS explains that "[t]hese strips

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[40, 42, 43] may be of metal, or other suitable material, but are preferably of high-impact type plastic." Therefore, Applicant suggests that the boot is otherwise made of conventional materials, such as described in column 1, lines 14-19, i.e., "... the same design and construction as any other work or sports boot, being made of a heavy material ...."

Therefore, Applicant respectfully submits that statement made in both grounds of rejection, characterizing the disclosure of PHILLIPS with the assertion "said cover being more rigid than said upper front surface and said flexion fold zone of the shoe, since the cover is more rigid than the upper front surface (specially when made of metal) ...," on page 3, lines 4-6, and on page 4, lines 3-5, *is erroneous*.

PHILLIPS nowhere states that the cover 30 is made of metal, with the exception of the insert 40, and the insert 40 only protects the shin, i.e., the front of the tibia.

In independent claim 29, which stands rejected as being anticipated by PHILLIPS, Applicant calls for the cover to be rigid or semi-rigid at the flexion fold zone (i.e., at the instep area) to increase flexural rigidity in the flexion fold zone.

PHILLIPS fails to teach or suggest a rigid or semi-rigid cover at the flexion fold zone.

In addition, ELLIS fails to teach or suggest a rigid or semi-rigid cover at the flexion fold zone.

At least for this reason, reconsideration and withdrawal of the rejection of claim 29 and the claims depending therefrom, is kindly requested.

There is, however, an additional reason why the rejection of claims 29, 32-34, 42, and 53 should be withdrawn. Specifically, in the amendment above, Applicant has amended independent claim 29 to specify that the cover is connected to the sole by being articulated thereto between the top and bottom of the sole.

In PHILLIPS, the tongue 30 "is hingedly attached to the boot 10 near the toe 16. An extending portion of the tongue 30 is covered by a triangular metal plate 32 and secured to the

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boot by rivets 34." See column 2, lines 13-16. As shown in the drawings, the rivets are on top of the forefoot region of the upper. The cover is not connected to the sole and is not articulated to the sole.

Further, and with reference to the §103(a) rejection of other claims, which relies additionally upon ELLIS, Applicant acknowledges the teaching of the hinge 40 connected between the guard flap 36 and the attaching plate 38. However, unlike Applicant's articulation, which is made between the top and bottom of the sole, the hinge 40 is located on top of the sole.

At least for the foregoing reasons, reconsideration and withdrawal of the rejection of claims 29, 32-34, 42, and 53 is kindly requested.

**D. Withdrawal of Rejection Under 35 USC §103(a)**

Applicant requests that the rejection of claims 14-23, 25-28, 30, 31, 35-41, 43, 44, 46-52, and 54-61 as being unpatentable over PHILLIPS in view of ELLIS be reconsidered and withdrawn.

Independent claims 14, 15, and 44 have been amended, like claim 29 mentioned above, to refer to the aforementioned articulation of the cover between the top and bottom of the sole. Neither PHILLIPS nor ELLIS teach or suggest same. Accordingly, reconsideration and withdrawal of the rejection of claims 14, 15, and 44 is requested at least for this reason.

Independent claim 30 has been amended to refer to the feature of the invention that the cover comprises a continuous rigid or semi-rigid material that extends continuously from within the upper part of the cover, through the intermediate part, and within the lower part, and, in addition to that, claim 30 has been amended to specify that the lower part of the cover is then connected to the sole, so that the wearer of the boot can transmit forces from his/her lower leg to the sole of the boot. Neither PHILLIPS nor ELLIS, nor any reasonable combination of PHILLIPS and ELLIS, teach or suggest the subject matter of claim 30.

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As mentioned above, the continuous rigidity of the cover -- or front spoiler -- from the tibia zone to the sole is beneficial to achieve the object of the invention of enabling transmission of forces, particularly during snowboarding. There would have been no reason to have modified the boots of PHILLIPS or ELLIS in a way that would have resulted in Applicant's invention, particularly in view of the different objectives of those two boots.

In independent claim 58, which refers to a "front spoiler" of a snowboard boot assembly, rather than to a "cover," Applicant additionally refers to the front spoiler as being attached "at transversely spaced apart attachment points between a top and a bottom of said sole." See, e.g., attachment points at openings 3, 3 in Applicant's Fig. 1. Neither of PHILLIPS and ELLIS teach or suggest such limitation.

New claim 62 depends from independent claim 58 and adds the limitation referring to the spoiler as comprising a rigid material that extends continuously from within the tibial support zone, through the flexion fold zone, and to within the front end zone. Neither PHILLIPS nor ELLIS teach or suggest such construction.

New claim 63 depends from claim 62 and includes, for example, a limitation that the cover has sufficient rigidity to retain its shape in the open position. PHILLIPS is not believed to teach or suggest same.

Finally, new claim 64 depends from independent claim 30 and adds the limitation that the lower part of the cover is connected to the sole by being articulated to the sole between the top and bottom of the sole.

#### **SUMMARY AND CONCLUSION**

Entry of the amendment is requested, together with reconsideration and withdrawal of the rejections for reasons of record and for additional reasons advanced above.

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A check is attached for payment of a fee for a three month extension of time and for additional dependent claims. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. 571-273-8300) on January 19, 2006.

  
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Jan. 19, 2006

Date